

REMARKS

I. Introduction

In response to the Office Action dated April 23, 2003, FIGS. 1 and 3 have been amended. Further, the specification has been amended, and the abstract has been amended. Also, claims 1, 11, 12, 20, and 30 have been amended, and claims 31-34 have been added. Claims 1-34 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

II. Drawing Amendments

Paragraph 1 of the Office Action objected to the drawings for failing to show the graphical user interface of claims 11, 20, and 30. FIGS. 1 and 3 have been amended to provide a graphical user interface 115 within the screen 116 of PDA 114 and television 112. Support for such amendments to the drawings is found in the original specification on page 8, lines 24-29. In this regard, the specification has also been amended to merely add the number 115 to the preexisting "graphical user interface" language therein.

III. Specification Amendments

As described above, the number "115" was added to the specification to provide support for the amended figures.

In addition, paragraph (2) of the Office Action rejected the abstract for exceeding 150 words in length. At the time the application was filed, the Abstract was permitted to be 250 words. Nonetheless, Applicant amends the abstract herein to comply with the 150 word requirement. In this regard, a substitute Abstract is attached hereto.

IV. Non Art Rejection

Claims 11, 20, and 30 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicants have amended claims 11, 20, and 30 deleting the objectionable term.

V. Office Action Prior Art Rejections

In paragraphs (4)-(5), the Office Action rejected claims 1-3, 8-9, 12-13, 18, 21-23, and 28 under 35 U.S.C. § 102(b) as unpatentable over Wharton et al., U.S. Patent No. 5,831,664 (Wharton). In paragraphs (6)-(7), the Office Action rejected claims 10, 19, and 29 under 35 U.S.C. §103(a) as being unpatentable over Wharton in view of Applicant's admitted prior art. Specifically, claims 1-2, 12, and 21-22 were rejected as follows:

In consideration of claims 1-2, 12, and 21-22, the Wharton et al. reference discloses a method, system, and article of manufacture for facilitating communications between a "hand held computing device" [12] inherently comprising a "memory", a "set top box" [16], and an "output" [14/PDA screen (not labeled)]. Assuming that both the "first" and "second set top box" are the same, as outlined in claim 2, the claimed limitations are met such that the "set top box" [16] is operable to "receive audio/visual information" from the server [18] that was requested by the "hand held computing device" [12]. This information is subsequently "transmitted to" and "stored in" the "hand held computing device" [12]. The claims do not require that the "audio/visual information" is necessarily the same throughout the claim, nor does it explicitly restrict the boundary of "audio/visual information" such that it precludes that the messaging (Figure 4) between the "hand held computing device" [12] and the "set top box" [16] may not be broadly interpreted as a form of "audio/visual information" given that it is an information message pertaining to a request of a particular "audio/visual" presentation or multimedia application. Accordingly, the "hand held computing device" [12] may subsequently "transmit" further "audio/visual information" to the "set top box" [16] wherein the server [18] is operable to provide "audio/visual information" to the "set top box" [16], which is subsequently displayed to an "output device" [14] (Col. 3, lines 26-67 – Col. 4, Lines 1-28).

Applicant respectfully traverses the above rejections. Independent claims 1 and 12 have been amended similar to the original form of independent claim 21. Such amendments illustrate that the audio/visual information provided from the second set top box to the output device is the information (the same information) that is received from the handheld computing device.

Accordingly, contrary to the assertion in the Office Action, the same audio/visual information is transmitted from the hand held computing device to the set top box and then to the output device where it is displayed. Thus, the audio/visual information that is displayed is the same information that is transmitted from the hand held computing device to the set top box. In this regard, while Wharton may provide for sending an information message to a set top box, that message is not then transmitted to the output device. Instead, the message is used to retrieve a particular audio/visual presentation from the server which is then transmitted to Wharton's interactive terminal where it is displayed. Such a teaching is inconsistent with the present claims that provide for the output device being provided with the information received from the hand held computing device. Such an inconsistency also renders the claims novel and non-obvious in view of

Wharton. In this regard, Applicant submits that Wharton fails to teach, disclose, or suggest, either implicitly or explicitly, various elements of the invention as claimed.

In view of the above stated differences, Applicant submits that the present independent claims are patentable over Wharton.

In paragraph (8) of the Office Action, claims 1-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perlman, U.S. Patent No. 6,169,879 (Perlman) in view of the PocketTV™ article. Specifically, claims 1-2, 12, and 21-22 were rejected as follows:

In consideration of claims 1-2, 12, and 21-22, the Perlman et al. reference discloses a method, system, and article of manufacture for facilitating communications between a "set top box" [40] and a VCR [130]. As there is no explicit recitation that the "first" and "second set top box" are the different, the examiner shall presume that they are the same for all dependent claims, as recited claim 2 and 22. The reference discloses that the "set top box" [40] is operable to "receive" and "transmit audio/video information" from/to any of the connected sources including a VCR [130] (Col. 9, lines 23-30, 46-49). The reference further teaches that the VCR [130] is operable to "store" the "audio/video information" from any of the connected sources and to subsequently "transmit" the stored material to the "set top box" [40] for display on an "output device" [110] (Col. 9, lines 58-61).

The reference, however, does not explicitly disclose nor preclude that the aforementioned VCR [130] may not be a "hand held computing device having a memory" as embodied by a PDA. It is arguable that the VCR [130] may be broadly construed as being a hand held computing device, in so far as it is feasible that at some point in time it may be "hand held" while being carried or moved. Assuming arguendo, the Perlman reference suggests that the "set top box" [40] is operable to interconnect any consumer electronic device (Col. 6, lines 43-60). The "PocketTV Brings Video to Palm-size PC" article explicitly discloses that with their software a "handheld or Palm-size PC becomes a miniature VCR". Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a "hand held computing device having a memory" as a VCR as disclosed in the PocketTV™ article in conjunction with the "set top box" [40]/VCR [130] interconnection teachings of Perlman for the purposes of enabling the recording/storage of "audio/visual information" on a device that may advantageously allow for the storage of an entire movie in your pocket (PocketTV™ article).

Applicant respectfully traverses these rejections. Specifically, the capability for a handheld computing device to transmit audio/visual information to a set top box which is then displayed on an output device (as claimed) is not described, taught, or suggested by either Perlman or the PocketTV article, either alone or in combination.

The rejection relies on the PocketTV article to teach the hand held computing device having a memory. In this regard, the PocketTV device is equated to a VCR with various capabilities consistent with Perlman. However, the PocketTV device is not equivalent to the claimed hand held computing device and does not perform or provide the same capabilities as claimed.

The article does state that the Palm-size PC becomes a miniature VCR. However, the information that follows in the article clearly illustrates that the PocketTV merely has the capability

to display video on the Palm-size PC. In other words, the PocketTV is merely a TV that fits in your pocket (i.e., a Pocket TV). Further, the "VCR" capabilities cited in the article merely refer to the ability to play the content on the Palm-size PC. The fourth paragraph of the article further elaborates that the streaming video is brought directly to "your pocket". Thus, the PocketTV device is clearly limited to receiving the MPEG video and is not capable of transmitting that video back to a set top box as claimed.

Further, merely stating that a "palm-size PC becomes a miniature VCR" does not teach, describe, or suggest that the palm-size PC is capable of (1) recording audio/visual information transmitted from a set top box; and (2) transmitting audio/visual information stored in the device to a set top box for playback on another device. This lack of capability to transmit information from the PocketTV palm-size PC clearly illustrates and teaches away from equating the PocketTV palm-size PC to the VCR used in Perlman. Further, since the PocketTV article merely provides for displaying the video on the palm-size PC itself, the article teaches away from transmitting and/or displaying the audio/visual information on another second device.

The MPEP §706.02(j) provides that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Further, "a reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference's disclosure will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the Applicant. *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130 (Fed. Cir. 1994). "If when combined, the references 'would produce a seemingly inoperative device,' then they teach away from their combination." *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130 (Fed. Cir. 1994) (quoting *In re Sponnable*, 405 F.2d 578, 587, 160 U.S.P.Q. 237, 244 (C.C.P.A. 1969).

The Office Action provides that the suggestion to combine would be generally available to one of ordinary skill in the art. However, in view of the fact that the PocketTV article teaches away from transmitting information to a set top box and the fact that the capabilities as described in the

article are limited to display on the palm-size PC itself, Applicant submits that one of general knowledge would not be motivated to combine the references.

In view of the above arguments, Applicant submits that neither Perlman nor the PocketTV article teach, disclose, or suggest the invention as claimed. Further, the PocketTV article cannot be combined with the Perlman reference. In this regard, the PocketTV article teaches away from the combination with Perlman and teaches away from the invention as claimed.

In addition, the various elements of the Applicant's claimed invention together provide operational advantages over the systems disclosed in Wharton, Perlman, and PocketTV™ article. In addition, Applicant's invention solves problems not recognized by Wharton, Perlman, and PocketTV™ article.

VI. Dependent Claims

Dependent claims 2-11, 13-20, 22-30, and 31-34 incorporate the limitations of their related independent claims, and are therefore patentable on this basis. In addition, these claims recite novel elements even more remote from the cited references.

Applicant has added dependent claims 31-34 which specifically provide that the two set-top boxes are different set top boxes. Such claims are clearly distinguishable over all of the cited references and contrary to the assumption taken by the Examiner in the Office Action.

Accordingly, in view of the above, the Applicant respectfully requests that these claims be allowed as well.

VII. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

HUGHES ELECTRONICS CORPORATION

By: 

Name: Georgann S. Grunebach *Aug 22, 2003*

Reg. No.: 33,179

Date:

GSG/JSF/sjm
G&C 109.19-US-01

FAX RECEIVED

AUG 25 2003

GROUP 2600

OFFICIAL